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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/668,294   | 09/24/2003  | Akio Yamamoto        | 0229-0778P          | 2254             |
| 2292   | 7590        | 07/20/2004           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | HUNTER, ALVIN A     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3711                |                  |
| DATE MAILED: 07/20/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/668,294

**Applicant(s)**

YAMAMOTO, AKIO

**Examiner**

Alvin A. Hunter

**Art Unit**

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-4 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0924/2003.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakahara et al. (USPN 5967905).

Regarding claim 1, Nakahara et al. discloses a golf club head comprising a main body provided with a socket, and a weight member disposed in the socket, wherein the socket is a tubular portion extending to the inside of the main body and having a through-hole extending therethrough, wherein the weight member comprises a main portion accommodated to the through-hole and the weight member being secured in the through-hole by crushing a crush portion which is formed at the inner end of the main portion within the region of the inner end to protrude from the inner end of the socket, into the main portion so that the main portion expands, pressing on the surface of the through-hole (See Figure 1, and 4d-4f).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Takeda (USPN 5976033).

Regarding claim 1, Takeda discloses a golf club head comprising a main body provided with a socket, and a weight member disposed in the socket, wherein the socket is a tubular portion extending to the inside of the main body and having a

through-hole extending therethrough, wherein the weight member comprises a main portion accommodated to the through-hole and the weight member being secured in the through-hole by crushing a crush portion which is formed at the inner end of the main portion within the region of the inner end to protrude from the inner end of the socket, into the main portion so that the main portion expands, pressing on the surface of the through-hole (See Figure 1, 6A, and 6B).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (USPN 5976033).

Regarding claim 2, Takeda discloses a method of making a golf club head having a platy part 4 and a weight member 31 wherein the method comprises forming a socket integrally with the platy part, wherein the socket has a tubular portion 35 extending from an inner surface of the platy part and having a through hole 21 extending therethrough and the through-hole has an opening at an outer surface of the platy part and an opening at the inner end of the socket, forming the weight member, wherein the weight member has a main portion accommodated to the through-hole. The background of the invention discusses weights having a crush portion wherein the weight are caulked, or crushed, around the through-hole in order to hold the weight in place. It only noted that

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certain material may not be crushed. Therefore, one having ordinary skill in the art would have found it obvious to use the above method in conjunction with that taught within the background of the invention, in order to attach the weight to the club head.

Regarding claim 3, Applicant discloses that the size of the weight member is to ensure a snug fit. One having ordinary skill in the art would have come to the conclusion that caulking the weight member would the weight member a snug fit within the through-hole also; therefore, one having ordinary skill in the art would have found it an obvious mater of design choice.

Regarding claim 4, Takeda shows the main portion provided at the inner end with a flat surface surrounding the crush portion (See Figure 6A).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 70-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.

  
GREGORY VIDOVICH  
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